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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,689	07/09/2003	Robert L. Doubler	2131.000019	8552

43541 7590 02/27/2007  
WOOD, HERRON & EVANS (ZIMMER SPINE)  
2700 CAREW TOWER  
441 VINE STREET  
CINCINNATI, OH 45202

EXAMINER
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REESE, DAVID C

ART UNIT	PAPER NUMBER
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3677

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/618,689

Applicant(s)

DOUBLER ET AL.

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 6-9, 11, 12, 15, 16 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10, 13-14, 17, and 19-26 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/1/2006 has been entered. Consequently, the following is the current listing of claims in the instant application:

#### *Status of Claims*

- Claims 1, 14, and 26 were amended.
- Claims 6-9, 11-12, 15-16, and 18, are withdrawn.
- Claims 1-26 are pending.

### *Claim Rejections - 35 USC § 102*

- [1] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- [2] Claims 1-5, 17, and 26 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Batten, US-4,737,059, because the invention was patented or described in a printed publication

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in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Batten is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 1, Batten discloses a linear fastener system (1) (see figure below) comprising:

a collet member (2) having a base end (4), a top end (3), an inner engaging surface (10), and an outer ribbed surface (5) positioned about a central axis;

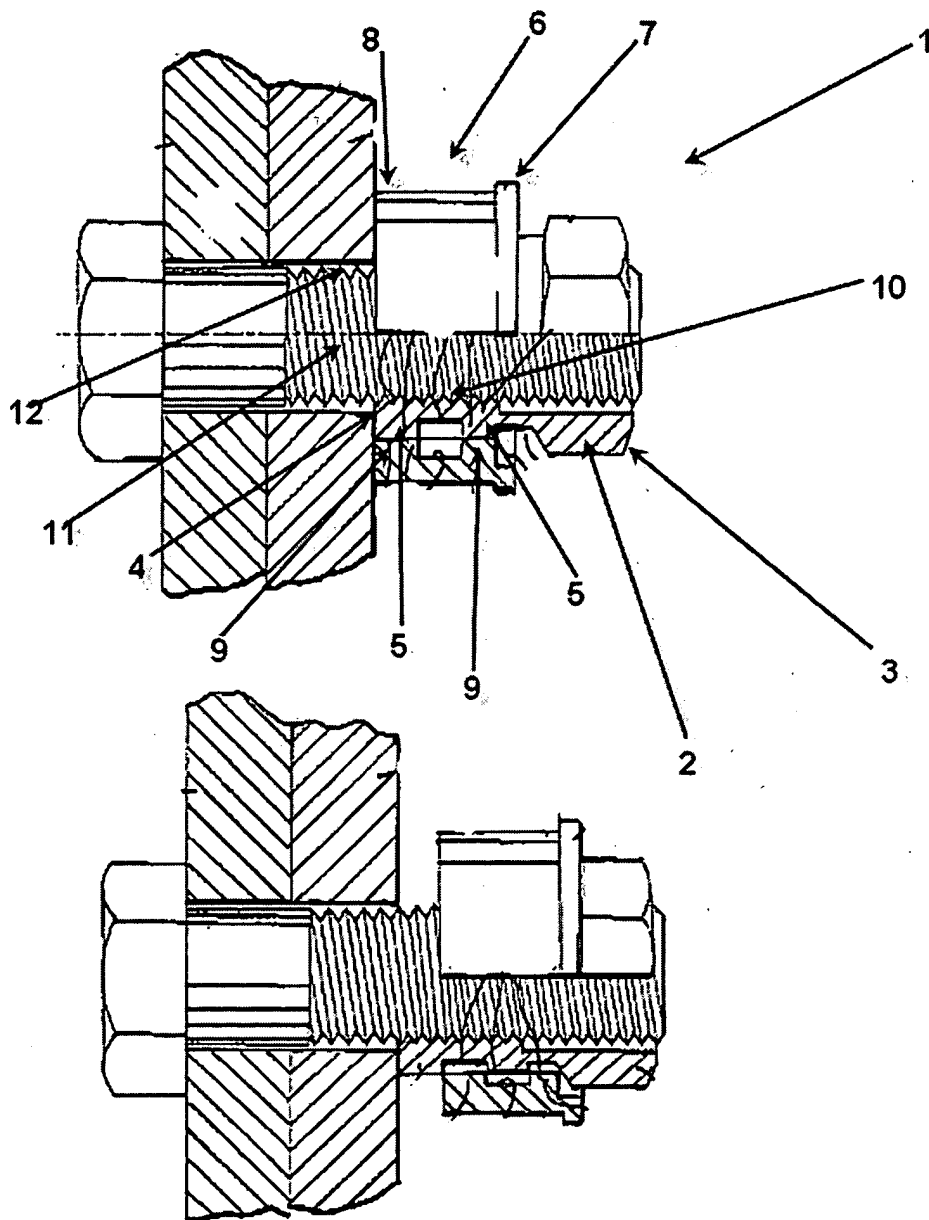
a compression ring member (6) having a base end (8), a front end (7), an inner ribbed surface (9) having at least one radially inwardly extending rib (9), and an outer surface (6) positioned about a central axis;

said inner ribbed surface (9) of said compression ring member (6) being constructed and arranged for coaxial alignment and overlapping engagement with respect to said outer ribbed surface (5) of said collet member (2), said compression ring member (6) non-rotationally linearly traversable with respect to said outer ribbed surface (5) of said collet member (2) between a first release position (bottom figure) and a second engaged position (top figure), wherein said engaged position (top figure) results in said outer ribbed surface (5) of said collet member (2) and said inner ribbed surface (9) of said compression ring (6) compressing said collet member (2) and tensilely loading said compression ring (6) member to engage a shank member (11) having an outer gripping surface (12) [whereby said collet member (2) is clamped to the shank member (11) without rotating said collet member (2)], and wherein said release position (bottom

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figure) results in expansion of said collet member (2) thereby releasing the outer gripping surface (12) of the shank member (11).

Examiner's note: the above statement in brackets is an example of intended use language; language that in the instant case fails to further limit the structure of the claimed invention. The prior art only needs to be capable of performing said function to be anticipatory, and in the instant case, the collet member of Batten is capable of being clamped to the shank member without rotating said collet member and thus remains anticipatory towards that of the claimed invention. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).



Re: Claim 2, wherein said shank member (11) includes a first end and a second end.

Re: Claim 3, wherein said ribbed outer surface (5) of said collet member (2) includes at least one outwardly and circumferentially extending rib (5), each said rib (5) including a first

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ramp surface to facilitate coaxially aligned linear overlapping movement of said compression ring (6) in relation to said collet member (2) for engagement thereof, and a second ramp surface to facilitate linear removal of said compression ring (6) from said collet member (2).

Re: Claim 4, wherein said inner engaging surface (10) of said collet member (2) is constructed and arranged with a conjugate shape in relation to said outer gripping surface (12) of said shank member (11).

Re: Claim 5, wherein said inner engaging surface (10) of said collet member (2) constructed and arranged with internal threads (10).

Re: Claim 17, wherein said outer ribbed surface (5) of said collet member (2) and said inner ribbed surface (9) of said compression ring member (6) are constructed and arranged to maintain an axially aligned interfitting relationship in said release position (bottom figure).

As for Claim 26, Batten discloses a linear fastener system (1) (see figure above) comprising:

a collet member (2) including an outer ribbed surface (5) defining peaks and valleys, and an inner surface (10) adapted to grip a corresponding surface (12) of a shank (11) in a locked condition of said fastener system (see figure above) and

a compression ring (6) including an inner ribbed surface (9) defining peaks and valleys corresponding to said peaks and valleys (5) of said collet member (2);

the linear fastener system having a locked condition (top surface) wherein said peaks of said collet member (2) and said peaks of said compression ring (6) are in confronting alignment, and an unlocked condition (bottom figure) wherein said peaks of said collet member (2) are

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disposed in said valleys of said compression ring (6), whereby said collet member (2) [may be clamped to the shank (11) in said locked condition without rotating said collet member (2)].

Examiner's note: the above statement in brackets is an example of intended use language; language that in the instant case fails to further limit the structure of the claimed invention. The prior art only needs to be capable of performing said function to be anticipatory, and in the instant case, the collet member of Batten is capable of being clamped to the shank member without rotating said collet member and thus remains anticipatory towards that of the claimed invention. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

[3] Claims 1-5, 10, 13, and 17 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Freedland et al., US-6,162,234, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Freedland et al. is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 1, Freedland et al. discloses a linear fastener system (see figure below) comprising:

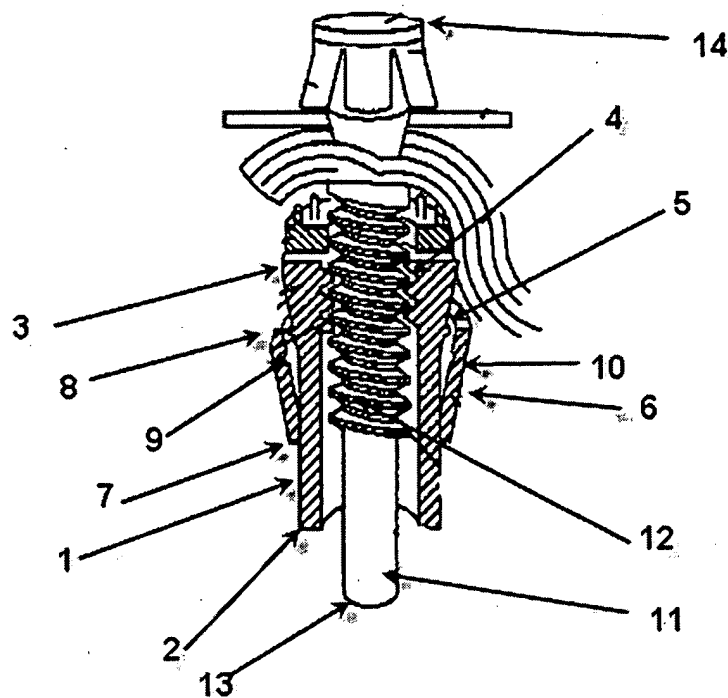


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a collet member (1) having a base end (2), a top end (3), an inner engaging surface (4), and an outer ribbed surface (5) positioned about a central axis;

a compression ring member (6) having a base end (7), a front end (8), an inner ribbed surface (9) having at least one radially inwardly extending rib (9), and an outer surface (10) positioned about a central axis;

said inner ribbed surface (9) of said compression ring member (6) being constructed and arranged for coaxial alignment and overlapping engagement with respect to said outer ribbed surface (5) of said collet member (1), said compression ring member (6) non-rotationally linearly traversable with respect to said outer ribbed surface (5) of said collet member (1) between a first release position and a second engaged position, wherein said engaged position results in said outer ribbed surface (5) of said collet member (1) and said inner ribbed surface (9) of said compression ring (6) compressing said collet member (1) and tensilely loading said compression ring (6) member to engage a shank member (11) having an outer gripping surface (12) whereby said collet member (2) is clamped to the shank member (11) without rotating said collet member (2), and wherein said release position results in expansion of said collet member (1) thereby releasing said outer gripping surface (12) of said shank member (11).



Re: Claim 2, wherein said shank member (11) includes a first end (14) and a second end (13).

Re: Claim 3, wherein said ribbed outer surface (5) of said collet member (1) includes at least one outwardly and circumferentially extending rib (5), each said rib including a first ramp surface to facilitate coaxially aligned linear overlapping movement of said compression ring (6) in relation to said collet member (1) for engagement thereof, and a second ramp surface to facilitate linear removal of said compression ring (6) from said collet member (1).

Re: Claim 4, wherein said inner engaging surface (4) of said collet member (1) is constructed and arranged with a conjugate shape in relation to said outer gripping surface (12) of said shank member (11).

Re: Claim 5, wherein said inner engaging surface (4) of said collet member (1) constructed and arranged with internal threads (4).

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Re: Claim 10, wherein said first end (14) of said shank member (11) includes a tensioning means (111E1 in Fig. 43), said tensioning means (111E1 in Fig. 43) being constructed and arranged to allow said shank member (11) to be tensilely loaded (via 6) prior to linear traversal of said compression ring member (6) into said engagement position with respect to said collet member (1).

Re: Claim 13, wherein said shank member tensioning means (111E1 in Fig. 43) includes at least one internal bore (111E1 in Fig. 43) extending inwardly from said first end of said shank member (14 in view of 111E1 in Fig. 43) along the longitudinal centerline of said shank member (11), wherein said at least one internal bore (111E1 in Fig. 43) is constructed and arranged for gripping and placing a tensile load (via 6) on said shank member (11) prior to linear traversal of said compression ring member (6) into said engagement position with respect to said collet member (1).

Re: Claim 17, wherein said outer ribbed surface (5) of said collet member (1) and said inner ribbed surface (9) of said compression ring member (6) are constructed and arranged to maintain an axially aligned interfitting relationship in said release position (with compression member (6) near the bottom of said collet member, (1)).

***Claim Rejections - 35 USC § 103***

[4] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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[5] Claims 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Batten, US-4,737,059, in view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

The difference between the claims and Batten is that Batten does not expressly disclose the different materials that may constitute the parts of his device. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to create the device out of plastic (claim 19), copper (claim 20), brass (claim 21), bronze (claim 22), aluminum (claim 23), steel (claim 24), and/or rubber (claim 25), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material

[6] Claims 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedland et al., US-6,162,234, in view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

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a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

The difference between the claim and Freedland et al. is that Freedland et al. does not expressly disclose the different materials that may constitute the parts of his device. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to create the device out of plastic (claim 19), copper (claim 20), brass (claim 21), bronze (claim 22), aluminum (claim 23), steel (claim 24), and/or rubber (claim 25), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material.

#### ***Allowable Subject Matter***

[7] Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: the prior art, either alone or in combination with corresponding limitations as stated above, fails to teach or disclose wherein said internal bore includes internal threads.

#### ***Response to Arguments***

[8] Applicant's amendment and arguments filed 11/1/2006 regarding rejections under Batten, US-4,737,059 under 35 U.S.C. 102 have been fully considered but they are not persuasive. In the instant case, the examiner maintains that the prior art of Batten remains anticipatory towards

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that of the amended subject matter as found in independent claims 1 and 26. Though Batten may not expressly teach of securing the collet member onto the shank member without rotating said components, since the amendment to the claims involved the use of functional language, without adding any true additional structural limitations, as discussed above, all the prior art needs to be capable of is performing said function. Thus, the examiner maintains that the collet member of Batten is indeed capable of being secured to the shank member without rotating said components. One may simply force the threads of the collet member onto the external threads of the shank member.

[9] Applicant's amendments and arguments filed 11/1/2006 regarding rejections under Freedland et al. under 35 U.S.C. 102 have been fully considered but they are not persuasive. Applicant primarily refutes the application of Freedland et al. in the instant set of amended claims stating that Freedland et al. does not disclose an inner ribbed surface with "at least one radially inwardly extending rib." The examiner disagrees. Applicant is reminded that claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974), and that things clearly shown in reference patent drawings qualify as prior art features, even though unexplained by the specification. *In re Mraz*, 173 USPQ 25 (CCPA 1972). In view of such, the examiner maintains that in the broadest reasonable interpretation, Freedland et al., does indeed possess an inner ribbed surface with "at least one radially inwardly extending rib."

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*Conclusion*

**[10] THIS ACTION IS NON-FINAL**


**[11]** Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

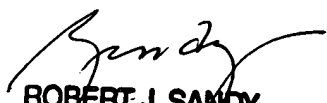
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DCR

David Reese  
Assistant Examiner  
Art Unit 3677

  
2/11/07

  
ROBERT J. SANDY  
PRIMARY EXAMINER